

Remarks

With respect to Application No. 10/196,635 (hereinafter "the '635 application"), i.e., one of the parent applications of the instant application, in the outstanding Office Action, the Examiner has rejected claims 1-7, 9, 11-16, 18, 20-25, 27, 29-31, 34-38 and 40-41 under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,543,545, issued in the names of Chatterji et al., (hereinafter "Chatterji"). The Examiner has rejected claims 1-2, 8-9, 11, 34-35 and 39-40 under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,368,021, issued in the names of Strong et al., (hereinafter "Strong"). The Examiner has rejected claims 1-2, 10 and 34-35 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,750,571, issued in the name of Geeting, (hereinafter "Geeting"). The Examiner has rejected claims 10, 19 and 28 under 35 U.S.C. §103(a) as being unpatentable over Chatterji in view of United States Patent No. 5,468,153, issued in the names of Brown et al., (hereinafter "Brown"). The Examiner has rejected claims 17, 26 and 32-33 under 35 U.S.C. §103(a) as being unpatentable over Chatterji in view of Strong.

Claims 1-41 are currently pending, of which, claims 1, 14, 23, and 32-34 are in independent form. Applicant respectfully requests favorable reconsideration of the rejections in the outstanding Office Action of the '635 application.

Rejection Under 35 U.S.C. §102(e)

With respect to the '635 application, claims 1-7, 9, 11-16, 18, 20-25, 27, 29-31, 34-38 and 40-41 stand rejected under 35 U.S.C. §102(e) as being anticipated by Chatterji. Since the present application claims priority from Chatterji, Applicant respectfully submits that the §102(e) rejection is moot with respect to the present application.

With respect to the '635 application, claims 1-2, 8-9, 11, 34-35 and 39-40 stand rejected under 35 U.S.C. §102(e) as being anticipated by Strong. The present invention, as defined by claim 1, is directed to a method of completing a wellbore while drilling. The method includes drilling a portion of the wellbore, disposing a drill bit on an end of a drill string, positioning a completion assembly around a section of the drill string, locating the completion assembly and the drill bit in the wellbore, extending the wellbore by rotating the drill bit and advancing the drill string without rotating the completion assembly and ceasing the advancement of the drill string when the completion assembly has reached a desired depth. In particular, the present invention includes limitations directed to a completion assembly positioned around a section of the drill string.

Strong discloses a pile and method for installing the same. With reference to figures 1 and 2 of Strong, pile 1 is driven into the ground or seabed and secured therein by barbs. Pile 1

comprises pipe 2 and an elongated member 3 which is received therein. The pipe 2 includes bars comprising two generally planar portions 16, 17 joined together at fold line 18. Elongate member 3 is provided with a first drive spline 5 which is coupled to a second drive spline 6 to which drill bit 7 is connected. Drilling mud passes downwardly through elongated member 3 to cool the drill bit 7 and wash away debris.

Strong neither discloses nor suggests positioning a completion assembly around a section of the drill string. Applicant respectfully submits that the Examiner incorrectly asserts that the pipe 2 of Strong is equivalent to Applicant's claimed completion assembly. The pipe of Strong forms a portion of the pile and provides anchoring via the barbs. As described and illustrated by Strong, the pipe is not associated with completion operations. Hence, claim 1 of the present application is believed to be allowable over Strong.

Claims 2, 8-9 and 11 depend from claim 1 and add further limitations. Hence, claims 2, 8-9 and 11 of the present application are believed to be allowable over Strong.

Independent claim 34 is directed to an apparatus for completing a wellbore while drilling. Similar to claim 1, claim 34 includes limitations directed to the completion assembly. Hence, for reasons similar to those presented hereinabove, claim 34 of the present application is believed to be allowable over Strong.

Claims 35 and 39-40 depend from claim 34 and add further limitations. Hence, claims 35 and 39-40 of the present application are believed to be allowable over Strong.

Rejection Under 35 U.S.C. §102(b)

With respect to the '635 application, claims 1-2, 10 and 34-35 stand rejected under 35 U.S.C. §102(b) as being anticipated by Geeting. As previously discussed, claim 1 includes limitations directed to drilling a portion of the wellbore prior to positioning the completion assembly and the drill bit in the wellbore.

Geeting discloses a screen placement method and apparatus. With reference to figure 2 of Geeting, the screen placement apparatus 13 includes a hydraulic motor 34 for providing rotational torque to auger upper section 36. Motor 34 is pivotally connected to swivel weldment 38, which is connected to a respective boom of a carrying vehicle such as a backhoe or a skid steer loader. Ground screens 10 are positioned around auger pipe 60 and coupled to cutting tip 80 as best illustrated by figure 9. In operation, the hydraulic motor 34 is activated in order to advance cutting tip 80 in the ground and the ground screen 10 is placed into ground 12 while simultaneously drilling the hole in ground. Geeting describes the process of drilling and simultaneously placing the ground screens 10 in the ground as follows:

Motor 34 is then energized causing all the auger sections, along with disposable cutting tip 80, to rotate

therewith. Thus, ground screen 10 is placed into ground 12 by simultaneously drilling the hole in ground 12, drawing the drill cuttings up through the screen with the auger sections and discharging the drill cuttings out of disconnect unit 98 through discharge openings 130. Column 6, lines 44-50.

Assuming *arguendo* that the ground screen 10 of Geeting is equivalent to Applicant's completion assembly, as described by Geeting, the ground screen 10 and cutting tip 80 are positioned in the ground simultaneously to drilling the hole in the ground. This is contrary to Applicant's method wherein the completion assembly and the drill bit are positioned in the wellbore prior to extending the wellbore. Accordingly, Applicant respectfully submits that the §102(e) rejection of the '635 application is not applicable to the present application.

Claims 2 and 10 depend from claim 1 and add further limitations. Hence, claims 2 and 10 of the present application are believed to be allowable over Geeting.

Independent claim 34 is directed to an apparatus for completing a wellbore while drilling. Similar to claim 1, claim 34 includes limitations directed to the completion assembly and the drill bit being positioned in a drilled portion of the wellbore prior to extending the wellbore. Hence, for reasons similar to those presented hereinabove, claim 34 of the present application is believed to be allowable over Geeting.

Claim 35 depends from claim 34 and adds further limitations. Hence, claim 35 of the present application is believed to be allowable over Geeting.

Rejection Under 35 U.S.C. §103(a)

With respect to the '635 application, claims 10, 19 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chatterji in view of Brown. Since the present application claims priority from Chatterji, Applicant respectfully submits that the §103(a) rejection is moot with respect to the instant application.


With respect to the '635 application, claims 17, 26 and 32-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chatterji in view of Strong. Since the present application claims priority from Chatterji, Applicant respectfully submits that the §103(a) rejection is moot with respect to the instant application.

Conclusion

Entry of this amendment prior to examination of this continuation application is respectfully requested. The Examiner is requested to call the undersigned for any reason that would advance the instant application to issue.

Dated this 3rd day of December, 2003.

Respectfully submitted:

A handwritten signature in black ink, appearing to read "Lawrence R. Youst", written over a horizontal line.

Lawrence R. Youst
Reg. No. 38,795
Danamraj & Youst, P.C.
Premier Place, Suite 1450
5910 North Central Expressway
Dallas, Texas 75206
Tel 214.363.4266
Fax 214.363.8177